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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/398,531	
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	First Named Inventor	Randall A. Addington	
	Art Unit	3711	
	Examiner Name	W Pierce	
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Application Number: 09/396,531

Group Art Unit: 3711

Filing Date: 9/15/99

Examiner Name: William Pierce

Inventors: Randall Addington et al.

Attorney Docket No.: 99-1001

Title: Bowler's Aid

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A Petition to make Special Under 37 CFR 102(c) has been granted in this Application and has been granted in parent application 09/130,905, filed 08/07/98

APPELLANTS' APPEAL BRIEF

- I. The Real Parties In Interest are the Applicants.
 - II. There are no related appeals or interferences.
 - III. Claims 33 to 58, are pending in this case. Appeal is taken on the rejection of all of the pending claims 33 to 58.
- Claims 1 to 32, previously in this case have been cancelled.

V.

SUMMARY OF THE INVENTION

A finger pad shield has a contact area on a first side for placement of the contact area in contact with a bowler's finger pad. See page 12, lines 23-25, Figure 1, page 13, lines 27 - 28, page 23, lines 14 - 15. The finger pad shield is made rigid for distributing the force produced by a maximum natural force lifting the bowling ball upon its release, over the contact area in contact with the finger pad. Page 5, lines 1-14, page 8, lines 1-9, page 13, lines 1 - 10, page 22, lines 9-18 page 23, lines 8 - 28, page 24, lines 1-10. The finger pad shield is made rigid or substantially rigid to resist deformation from the maximum natural force produced when lifting the ball in its release. The maximum natural force is within a range limited by a limit of muscular skeletal development. Page 23, lines 23 - 28, page 24, lines 1 - 7. The finger pad shield may be placed in the finger part of a glove. See Fig 3, page 18, lines 1 - 8, and may be a fixed part or removable, page 24, lines 17 - 22. The finger pad shield may have a raised surface extending away from the surface of the finger pad shield, to limit the depth of insertion of the finger pad shield into the bowling ball finger hole. Figure 6, page 21, lines 4 - 23. The finger pad shield may be connected to a rigidly deflectable support to deflect under said force of the bowling ball and to produce a counter force for restoring the support to a stable position. Page 12, page 13 lines 1 - 10, Figure 1.

VI.
ISSUES

1. Whether Claims 40 to 45 are indefinite under the 2nd Paragraph of 35 U.S.C. 112.
2. Whether claims 33, 34, 36, 38-43 and 45 to 58, are anticipated by Fowble under 35 U.S.C. 102(b).
3. Whether claims 33, 37, 44, and 57, are rejected under 35 U.S.C. 103(a) as unpatentable over Fowble in view of Pratt.

VII.
GROUPING OF CLAIMS

No statement is submitted regarding grouping of any of the claims in the respective separate grounds of rejection under Section Vi, paragraphs 1, 2 and 3.

VIII.
ARGUMENT

A.
Standards For Patent Examination

1.
The Examination Standard of Substantial Evidence

The standard for patent examination, is the Standard of Substantial Evidence, as applied to any rejection of a claimed invention. This standard is required as a matter of law and must be met by the record fact and acceptable reasons supporting examiner's grounds for rejection.

In re. Zurko 258 F.3d 1379, 1381 (Fed.Cir. 2001), established the U.S. Patent Office Examination Standard of Substantial Evidence (hereafter Examination Standard of Substantial Evidence,") as the proper standard for the examination of factual findings in patent examinations. In explanation of the Standard of Substantial Evidence, the Court stated,

Substantial evidence is 'such reasonable evidence as a reasonable mind might accept as adequate for a conclusion.' . . . A review under this standard 'involves an examination of the record as a whole, taking into consideration evidence that both justifies and detracts from the agency's decision.'

Speaking of this Standard of Substantial Evidence, as applied to a decision rejecting an application for patent, the Court, relying on *In re. Zurko*, said,

Judicial review of a Board decision denying an application for patent is thus founded on the obligation of the agency to make the necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusions. See *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (review is on the administrative record); *In re Gartside*, 203 F.3d 1305, 1314, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000) (Board decision "must be justified within the four corners of the record").

In re. Sang-Su Lee 277 F.3d 1338, 1342, 1343 (Fed. Cir. January 18, 2002)

The Court's direction in applying the Standard of Substantial Evidence, "with respect to core factual findings in a determination of patent ability," the Court instructions, referring to the Board of Patent Appeals and Interferences, said,

... the Board cannot simply reach conclusions based on its own understanding or expertise or on its assessment of what w basic knowledge or common sense. Rather the Board must point to some concrete evidence in the record in support of its factual findings.

In re. Zurko, at 1386

The deficiencies of the cited references cannot be remedied by general conclusions of what is know by common sense or basic knowledge, and any assessment of basic knowledge or common sense, which is not based on evidence in the record, lacks substantial evidence support.

In re. Zurko, at 1385.

In a rejection based on obviousness (35 U.S.C. 103) the Court said,

The factual inquiry whether to combine references must be thorough and searching."

Id. It must be based on objective evidence of record. This precedent has been reinforced

in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124_25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'") (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

In re Sang-Su Lee 277 F3d. 1338, 1342, 1343 (Fed. Cir. January 18, 2002)

2.

Manual of Patent Examining Procedure §2131 Anticipation

Anticipation requires that a claim is anticipated under 35 U.S.C. 102, only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The identical invention must be shown in as complete detail as is contained in the claim.

3.

MPEP §2112 Requirements of Rejection Based on Inherency; Burden of Proof

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.

4.

Legal Concept of Prima Facie Obviousness

In a rejection based on obviousness (35 U.S.C. 103) the Court said, "The factual inquiry whether to combine references must be thorough and searching." Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a

showing of the teaching or motivation to combine prior art references."); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

To establish a prima facie case of obviousness under 35 U.S.C. 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must

expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

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The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

Manual of Patent Examining Procedure §2142 Legal Concept of Prima Facie Obviousness

5.

MPEP §2173.01 Claim Terminology.

A fundamental principle contained in 35 U.S.C. 112, second paragraph is that applicants are their own lexicographers. They can define in the claims what they regard as their invention essentially in whatever terms they choose so long as the terms are not used in ways that are contrary to accepted meanings in the art. Applicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 226 (CCPA 1971), a claim may not be rejected solely because of the type of language used to define the subject matter for which patent protection is sought.

6.

MPEP §2173.05(g) Functional Limitations.

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as

evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

7.

MPEP §2173.05(b) Relative Terminology.

The fact that claim language, including terms of degree, may not be precise, does not automatically render the claim indefinite under 35 U.S.C. 112, second paragraph. Acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

8.

MPEP §2173.06 Prior Art Rejection of Claim Rejected as Indefinite.

All words in a claim must be considered in judging the patent ability of a claim against the prior art.

B.

Introduction To Appellants' Arguments

Examiner's statements made in rejecting appellants' claimed invention, are repeated in this brief so there is no mistaking what Examiner has said as grounds for the final rejection. Examiner's stated grounds do not show where or how each element of the record claims are anticipated or are prima facie obvious. Instead, Examiner refers to some of the claim parts, uses unsupported rules to remove claim recitations from examination under 35 U.S.C. 102 and 103, and refers to parts of Fowble and Pratt, but without identifying where in the record or how, the asserted elements of these references make the record claims anticipated or obvious.

Examiner has not given appellants an examination of the patent. Examiner's grounds fail the standards for examination set forth in Section A, above, and as stated below. For the Board to reject appellants' claims, it will be required to offer new grounds of rejection and complete the examination of this application based on the references cited.

Examiner has failed in the attempt to provide a legal ground for rejection of applicants' claims that meets the examination standards set forth in Section A., above and in particular has failed to meet the Examination Standard of Substantial Evidence, according to the rule imposed by U.S. Supreme Court and the U.S. Court Of Appeals For The Federal Circuit, on the U.S. Patent and Trademark Office Board of Patent Appeals and Interferences or the MPEP. Failure to meet that examination standard shown by examiner's declarations based on self knowledge, demonstrates examiner's prejudgment of the examination standard as irrelevant to examiner's task and leaves examiner's record inadequate as a matter of law. Without record facts and reasons connecting the facts to conclusions in an acceptable manner, there is only examiner's opinion without any record which the Board can examine or appellants can be reasonably expected to argue and appellants are denied due process in confronting examiner and seeking redress for a illegal rejection of appellants' claimed invention.

C.

1.

Claims 40 to 45 Meet All Requirements of 35 USC 112

Examiner's rejection is restricted to his statement, for Claims 40 and 42.

In claims 40 and 42, the scope of 'maximum natural force' is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball. Such a variable is subjective, Claim 43 is inapt in that it fails to positively recite structure such that one can determine the metes and bounds of the claim. Currently the claim is only narrative with functional recitations that fail to further limit the elements in the previously recited claims.

Examiner's rejection under 112, 2nd Paragraph fails the Examination Standard of Substantial Evidence because it fails explain the facts or rationale of the rejection, in a manner reasonably providing Applicants an opportunity to respond to this rejection.

Examiner has illogically, selectively and, without explanation, parsed the record claims 40 and 42, without any explanation or rationale and relied on selected recited element "maximum natural force," without reference to the claims as a respective whole claimed invention, has failed to explain his claim interpretation or why or how examiner selected the parsed phrase "maximum natural force," to the exclusion of any other part of the recited claim and the basis and rationale in law, or why this phrase, according to examiner's conclusion, has no meaning in the claim taken as a whole. Appellant is left with examiner's opinion without facts or reasons, so it is not reasonably possible for appellant to understand this rejection in a way that Applicant to rebut

examiner's opinion, for example, that "maximum natural force relates to intended use," as stated by examiner.

Examiner conclusion, as stated is that

[i]n claims 40 and 42, the scope of 'maximum natural force' is indefinite. The term maximum relates to the intended use, by the strength of an individual, by the delivery of the ball and the weight of the ball.

That conclusion is an opinion without any support of record facts to support that opinion that the term "maximum," relates to intended use." Without record facts in support, why, as examiner states, "maximum natural force," is indefinite, examiner's rejection fails as based on examiner's self knowledge and a failure under the Standard of Substantial Examination. The conclusion "the term maximum relates to the intended use . . ." is indefinite as examiner has not informed appellants what is means by the relative term "relative."

Examiner has stated the rejected claim 43 is "narrative with functional recitations that fail to further limit the elements in the previously recited claims," without stating how or why or otherwise explaining his interpretation of the claim as "narrative," or "with functional limitations," makes the claim indefinite under 35 U.S.C. 112.

Examiner has failed to meet the Examination Standard of Substantial Evidence because examiner has not shown by record facts from the recited record claims, taken as a whole description of the invention, why or how the "maximum natural force is subjective," or why or how "[t]he term maximum relates to intended use . . . [and] a variable [and] is subjective," or why or how "it positively fails to recite structure [and] the metes and bounds."

The concept of a "maximum natural force," in the context of bowling and as a function of "muscular skeletal development," is explained in the specification of the application as follows.

The finger pad finger pad shield 14, may have a defined contact area. The finger pad finger pad shield when placed in contact with the bowler's finger pad 16 places a rigid surface between the force of the bowling ball against the finger pad 16 and spreads that force, when the bowler's maximum natural force is applied to the bowling ball in releasing the bowling ball. It is at this moment, when the force of the ball against the finger pad 16 is the greatest and the pressure within the area of contact or contact area made by the finger pad finger pad shield 14 with the finger pad 16, would be greatest if that bowling ball force was not spread over that contact area.

The rigid finger pad finger pad shield 14 is made sufficiently rigid to substantially resist deformation or flexing from the force of the bowling ball. Any less rigidity would allow the finger pad finger pad shield 14 to flex or deform under the force of the bowling ball, permitting a concentration of forces with the area of contact made by the finger pad shield 14 with the finger pad 16. The force which the rigid finger pad shield 14 is made to resist is within a range limited by the conventional limit of bowling ball weights and the limit of muscular skeletal development. In the sport of bowling, a bowler will choose a ball suitable to that bowler's muscular skeletal development and within the range of weight allowed by bowling authorities such as the American Bowling Congress. While a stronger bowler at the upper limit of muscular skeletal development, may prefer a heavier ball, the force applied from the bowling ball to the finger pad 16 will be in a range limited by the range of muscular skeletal development and the weight of the ball chosen from the range of weights available. In this way the rigid material of the finger pad shield means 14 prevents that force produced by the bowling ball from creating pressure spots on the finger tip or within the contact area made by the finger pad finger pad shield 14 with the bowler's finger pad 16, and reducing wear on, and fatigue of, the finger pad.

See Application Pages 23 - 24. See also "Objects of the Invention," Application Pages 4 - 6.

The force produced when a bowling ball is released is well known from the Shaffer patent 4,371,163 and to those skilled in the art. "Maximum natural force" is defined in the application with reference to a definite standard. Applicants recitation of "maximum natural force" is accurate anatomically, as circumscribed by the range of muscular skeletal development and the conventional weight of a bowling ball, as stated by Dr. W. Robert Addington, D.O. in the Rule 132 Declaration and the patent law does not require that all possible forces corresponding to the full range of muscular skeletal development from children to fully developed largest size males, be listed in the claims and meet the MPEP §2173.05(b) Relative Terminology.

See Rule 132 Declaration of Dr. W. Robert Addington, D.O., (submitted with this Amendment), stating, as a Board Certified Physician and expert in Rehabilitative Medicine, facts showing the "maximum natural force," as recited in the claims, is within a defined quantifiable range, that it is objectively measurable, and is not subjective.

Applicants have made a prima facie showing that claims 37 and 40 - 45 meet the 2nd Paragraph of 35 USC 112, and it is Examiner's burden to rebut that prima facie showing by substantial evidence. Appellants do not see where or how examiner has met that burden.

Examiner's limited statements are without record facts and fails explain the facts, basis in law or any other rationale of the rejection, in a manner reasonably providing Applicants an opportunity to respond to this rejection and this rejection fails the Examination Standard of Substantial Evidence.

2.

Rule 132 Declaration of Dr. W. Rober Addington, D.O.

The Rule 132 Declaration of Dr. W. Robert Addington, D.O., (submitted with, and made of record in this appeal brief, Dr. W. Robert Addington, D.O., states as a fully licensed physician by the State of Florida and a Board Certified Physician in Rehabilitative Medicine, facts showing the "maximum natural force," as recited in the claims, is within a defined range, that it is objectively measurable, and is not subjective. These facts are not addressed or rebutted in examiner's grounds for rejection.

Examiner has chosen to disregard, ignore, and read out of the application, the Rule 132 Declaration of Dr. W. Robert Addington, D.O. submitted and made of record with appellants' amendment dated 01/14/2003 and attached to and made of record in this appeal brief.

Examiner has stated Dr. Addington's Declaration is that of an expert providing an opinion that the pending claims meet the requirements of 35 U.S.C. 112. That examiner statement is incorrect and a misrepresentation of the Declaration.. Nowhere in the Declaration does Dr. Addington offer an opinion on 35 U.S.C. 112 or whether application or any part of it meets the requirements of 35 U.S.C. 112.

Dr. Addington's Declaration in part is,

The maximum of muscular skeletal development is determinable and objectively measurable inductively from knowledge of anatomy. The parts of the human anatomy which are used to properly release a bowling ball do have a maximum limit of muscular skeletal development.

This statement is made from my personal knowledge and observations as practicing physician with Board Certifications in Physical Medicine and Rehabilitation and Electro-diagnostic Medicene.

Examiner has stated the Declaration is,

... applicant impressions regarding what he intends to be meant by the 'force produced by the release of the ball.

This statement does not address Dr. Addington's statement of facts or rebut Dr. Addington's facts set forth in his Declaration. This examiner statement is an opinion without showing the record fact statement of Dr. Addington in the Declaration support that opinion.

Examiner states as an opinion that the Declaration "is less persuasive," as "an affidavit of an applicant," but does not say how much weight or significance it should or may be given or any facts or reasons therefore. This statement by examiner must be considered irrelevant as it conveys no understanding of which part of the Declaration examiner finds "less persuasive," and the reasons therefore.

Examiner has not rebutted, but has dismissed the facts of this Declaration, with opinions unrelated to the facts stated in the Declaration and by opinions unrelated to and misrepresenting the Declaration. Examiner's refusal to consider the facts stated in the Declaration, or to offer record based facts and reasons explaining examiner's conclusions, why the Declaration is no persuasive or relevant, makes examiner's rejection of claims 40 - 45 incompetent as a legally sufficient rejection of appellants' claimed invention.

3.

Examiner Has Failed To Meet The Examination Standard of Substantial Evidence And The Rejection of Claims 40 - 45 Under 35 U.S.C. 112, Should Be Vacated

Examiner's response to applicants' position on the rejection made under 35 U.S.C. 112, must state the record facts supporting examiner's conclusions and show by acceptable logic the reasons the record facts support examiner's conclusions. Examiner must show why the word examiner has identified in the claims as "indefinite," or "subjective," cannot be understood within the context of the claims or from the context of the specification. Examiner must explain which of the recitations do not define the "metes" and "bounds," and elements are recited "narratively," or "functionally," and how these elements fail to limit the elements. Examiner must show by reference to the record facts of the description of the invention as presented in the application and the claims why the claims are indefinite. Examiner must show by the record facts of the Declaration's recitations, why the Declaration is given no consideration.

Failure of examiner to rebut appellants' record facts and reasons why the claim recitations are definite and meet the requirements of 35 U.S.C. 112 and failure of examiner to show record facts or acceptable logic in support of examiner's conclusion, or examiner's opinion of the Declaration of Dr. W. Robert Addington, D.O., demonstrates examiner has failed to meet the examination standard of substantial evidence and the rejection made under 35 U.S.C. 112, must be vacated as incompetent as a matter of law.

D.

Claims 33, 34, 36, 38 to 43, and 45 to 58, Are Not Anticipated By Fowble

I.

The Limits To The Fowble Disclosure

Fowble is limited to a finger protector to protect the finger, without any disclosure, teaching, or showing, of protection for the finger pad. However, Fowble does describe the protector being of sufficient length to cover the entire finger. Page 1, lines 86 - 88. Fowble discloses the material may be made "more rigid," without disclosing any quantifiable or qualifiable standard or reference from which one skilled in the art may understand exactly "how" rigid" Fowble recommends or teaches the material may be except by telling us it should be rigid but not rigid to resist bending. Page 1, lines 32 - 41. To the extent of Fowble's disclosure, there is nothing qualifying or quantifying the term "rigid," to show, teach, or describe, to one skilled in the art, what Fowble means by "rigid," or how "thick" or "rigid" to make the protector except it should be "thicker and more rigid than heretofore employed". Page 1, lines 33 - 36.

Accordingly, any reference to Fowble disclosing a "shield made of rigid material," is not supported by record based facts, fails the Examination Standard of Substantial Evidence, and is meaningless in the context of the record claims. Fowble's disclosure is limited to a protector designed to fit over the finger and made of a "thicker" or more rigid" material that Fowble says was used previously but without disclosing what that previously used material is or was. Accordingly, Fowble does not disclose what kind of material is used, or what it does, except to prevent "galling" or "chafing" of the fingers. Page 1, lines 9 - 12.

Fowble is directed to prevent galling or chaffing of the fingers. Page 1, lines 9-12. The plain meaning of chaffing or galling, is to irritate or wear away by rubbing. Prevention of chaffing or galling does not require, or teach or describe a fixed relation of the protector of Fowble with the finger pad. The teaching and disclosure of Fowble is the protector may be positioned over the finger in any relation where the protector body is interposed between any part of the finger used to hold or grip the object and the object. The part of Fowble identified by Examiner as "strap 5," is not described except by reference to the drawing. Fowble describes the protector as having an open end to form an outlet for grit and sand liable to find its way between the protector and finger. Page 1, lines 67-74. This description of the protector open to allow accumulated grit or sand to leave through the "opening e to form an outlet, implies a loose fit where the Examiner identified "strap 5," does not provide any function except to prevent the loose fitting protector from falling away from the bottom of the finger. The foregoing is the limit of the Fowble disclosure of a "strap 5," and there is no disclosure beyond that limited disclosure of a strap or ring or any other means to hold the protector in a "fixed" or any other intended

relationship with the finger, as recited in the claims, except a loose fit limited to the protection of the fingers from lateral forces along the surface of the protector which may gall or chafe the finger.

Fowble makes no disclosure of any "raised surface," or "limit means, for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball, as recited in the claims. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, with its surface in line with the rounded exterior of the protector, and as described above is not "raised" relative to the claim as recited in combination with the "finger pad shield in claim 33, for example, as,

said finger pad shield includes a raised surface for contacting the surface of a bowling ball;

said raised surface is located proximate said open end and adapted to limit the depth of

insertion of said finger pad shield into the finger hole of a bowling.

The Examiner asserted "strap 5," can be seen by inspection as not a "raised surface . . . adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball," as recited in the claims.

In summary, Fowble's disclosure has no teaching or suggestion or disclosure of the structure of the material used in the disclosed protector. Fowble makes no disclosure of any "raised surface," or "limit means for limiting the depth of insertion of the finger pad shield into the finger hole of a bowling ball. The disclosure of Fowble of what Examiner identifies as "strap 5," is nothing more than a part of the protector, as described above.

While there is in Fowble, contact between the finger and the finger protector, Fowble only teaches a general area of possible contact or contact subject to change due to use. There is no disclosure in Fowble of "a contact area," or a "fastener," "to hold said contact area in a fixed relationship with a finger pad," as recited in the claims.

At best, Fowble discloses an undefined area over which the finger pad does not contact the protector in a fixed relationship with "a contact area," because the Fowble protector is disclosed as a loose fitting device, worn with enough clearance between the protector and the finger to allow sand and grit to accumulate and fall out, without intercession of the wearer, and disclosing a loose fit between the finger and the protector, permitting the finger to slide or move within the protector. There is no teaching or disclosure in Fowble of "a contact area," as the loose fit taught by Fowble, permitting the finger to move inside the protector, does not disclose and teaches away from "a contact area," and "said finger pad shield includes at least one fastener to

hold said contact area in a fixed relationship with a finger pad; wherein a maximum force produced in the release and lifting of the bowling ball, is spread over said contact area," as recited in representative claims 33 and 40.

The force of interest in Fowble and which the Fowble device is intended to prevent from galling or chaffing the wearer, as disclosed in Fowble, is a lateral force along the surface of the protector and no relation is shown, taught or described in Fowble of that force and any "contact area," whether explicit or implicit.

Examiner must show element by element in Fowble, each of the recited elements in the claims. Examiner has failed to show each claimed element as disclosed in Fowble.

2.

Fowble does not anticipate any record claims under 35 U.S.C. 102.

Anticipation under 25 U.S.C. 102 requires examiner show each recited element, in the applied reference, See Section A. 2 and 3, above.

a) Claim 33 recites,

A bowler's finger pad shield for protecting a finger pad from the force produced when applying lift to a bowling ball, to rotate or spin the ball at its release, comprising:

- a) a finger pad shield with an open end adapted for insertion of a finger pad, said finger pad shield including a first surface and a second surface, extending from said open end; said first surface including a contact area located proximate said open end and positioned relative to said open end to receive a finger pad;
- c) said second surface is opposed to said first surface;
- d) said finger pad shield is adapted for insertion into the finger hole of a bowling ball, to place said second surface in contact with a bowling ball finger hole; and wherein
- e) said finger pad shield includes at least one fastener to hold said contact area in a fixed relationship with a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area.

That Examiner has rejected the preamble is noted as irrelevant. The preamble reciting "A bowler's finger pad shield for protecting a finger pad from the force produced when applying lift to a bowling ball, to rotate or spin the ball at its release," sets forth the general purpose and environment for the use of the invention, as

claimed in paragraphs a to e.

Examiner's rejection of claim 33 (aside from his statement regarding the preamble), is restricted to his statements,

- 1) Fowble shows a finger A, with an open end e, a first surface b and a second surface d;
- 2) the second surface d clearly opposes the first surface b and a fastener a;
- 3) the functional limitation pertaining to the intended use such as . . . paragraph a. "adapted for insertion of a finger pad; and paragraph d, "wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area," do not distinguish over the art in an apparatus claim.

Examiner's rejection of claim 33 does not inform Applicants of the record facts of Fowble meeting each recited claim element or the rationale for excluding parts of the recited claim selected by Examiner and fails the Examination Standard of Substantial Evidence required to support a rejection under 35 USC 102.

Examiner's rejection of claim 33 fails to explain how, if at all, the Examiner alleged, "functional" limitations, were evaluated and considered as "not distinguish[ing] over the art in an apparatus claim.". Examiner's statements are conclusions without record fact support and show Examiner did not consider the alleged "functional limitations, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. See MPEP §2173.05(g) Functional Limitations, Section VI, B, 2, above.

Examiner's ground of rejection is limited to a showing in Fowble of a finger pad shield with an open end, and a first and a second surface. It does not explain how all of the claim 33 recitations were evaluated or considered and did not apply Fowble to all of the recited claim 33 elements. Instead Examiner selectively chose to disregard the recited claim as a whole while selectively choosing alleged "functional" limitations without applying these limitations to the claim elements or the claim as a whole or explaining how these elements would have been considered to the whole claim by one of ordinary skill in the art of bowling.

Examiner's ground of rejection of claim 33 denies to Applicants a reasonable opportunity to rebut because it materially and significantly relies on Examiner's unsupported opinions about what is a "functional" limitation and unexplained conclusions that the alleged "functional" limitations, should be disregarded. The standard of substantial evidence for patent examinations requires record facts, and acceptable application of the law to support conclusions. All Examiner has given as reasons for disregarding alleged "functional" limitation as "not distinguish[ing] over the art in an apparatus claim and disregarding material and significant

recited claim 33 elements, limited to his personal knowledge, which is unacceptable under the substantial evidence standard for examination.

Examiner must show element by element in Fowble, each of the recited elements in the claims. Examiner has failed to show each claimed element as disclosed in Fowble.

b) Claims 34 and 36.

Claim 34 recites,

The bowler's finger pad shield of claim 33, wherein said at least one fastener is a strap, said at least one fastener is a strap..

Claim 36 recites,

The bowler's finger pad shield of claim 33, wherein said at least one fastener is a ring.

Claims 34 and 36 depend on independent claim 33 reciting,

a fastener to hold said contact area in a fixed relationship against a finger pad; wherein a force produced in the release and lifting of the bowling ball, is spread over said contact area.

The examiner referred to part "a" of Fowble has not been shown by Examiner as meeting the combined recitations of claim 33 and claim 34 and 36 respectively. Examiner's rejection stating "As to claims 34 and 36 ... the fastener a is a strap considered a 'ring' and a 'glove' finger enclosure," is Examiner's opinion unsupported by record facts of the recited claim elements under the requirements of 35 USC 102, that the reference must teach every element of the claim.

Examiner must show element by element in Fowble, each of the recited elements in the claims.

Examiner has failed to show each claimed element as disclosed in Fowble. Examiner's rejection of claims 34 and 36, fails to meet the Examination Standard of Substantial Evidence and must be stricken.

c) Claims 38 and 39 recite.

Claim 38. The bowler's finger pad shield of claim 33, wherein said finger pad shield includes a raised surface for contacting the surface of a bowling ball; said raised surface is located proximate said open end and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

Claim 39 The bowler's finger pad shield means of Claim 38, wherein said raised surface extends in a direction away from said finger pad shield and said contact area.

The recited elements in these claims have not been shown in Fowble.

d) Claims 40 - 42 recite.

Claim 40. A bowler's aid for assisting a bowler in applying the a bowler's maximum natural force through the bowler's finger pad inserted in a bowling ball finger hole, in lifting and rotating the bowling ball at its release, comprising,

a) a finger pad shield with an open end adapted for insertion of a finger pad onto said finger pad shield; said finger pad shield including a contact area located proximate said open end and adapted to receive a finger pad in said contact area; and wherein,

b) said finger pad shield is substantially rigid to resist deformation, from a force produced when a maximum natural force is applied through a finger hole of said bowling ball, to lift and rotate said bowling ball at its release, to spread said force produced, over said contact area.

Claim 41. The bowler's aid of claim 40, wherein, said maximum natural force is in a range within the limit of muscular skeletal development.

Claim 42. The bowler's aid of claim 40, wherein said finger pad shield is adapted to spread said force produced over said contact area, substantially uniformly.

Examiner must show element by element where in Fowble, each of the recited elements in the claims are disclosed. Examiner has failed to show each claimed element as disclosed in Fowble. Examiner has not shown by record facts where each and every element of these claims are disclosed in Fowble, or rebutted the limits of the Fowble disclosure as presented by appellants.

Examiner's statement,

the range within the limit of muscular skeletal development is the amount of force applied from 0 to where a person can no longer increase the force exerted on the object. Such is inherent in Fowble.

does not show element by element in Fowble, each of the recited elements in the claims. Examiner has failed to show each claimed element as disclosed in Fowble or necessarily following from the disclosure of Fowble as inherent. Examiner has failed to meet the Examination Standard of Substantial Evidence.

e) Claims 38, 39, 45 and 53

f) Claims 38, 39, 44, 45, and 53. recite,

For Claim 38,

The bowler's finger pad shield of claim 33, wherein said finger pad shield includes a raised surface for contacting the surface of a bowling ball; said raised surface is located proximate said open end and adapted to limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

For Claim 39,

The bowler's finger pad shield means of Claim 38, wherein said raised surface extends in a direction away from said finger pad shield and said contact area.

For Claim 44,

The bowler's finger pad shield of claim 44, wherein said fastener is an enclosure for a finger and said finger pad shield is attached to said enclosure.

For Claim 45,

The bowler's aid of claim 40, wherein said finger pad shield includes a raised surface extending away from said finger pad shield and said contact area and adapted to contact the surface of a bowling ball; and limit the depth of insertion of said finger pad shield into the finger hole of a bowling ball.

For Claim 53,

The bowler's aid of claim 46, including means for contacting the surface of a bowling ball to limit the depth of insertion into the finger hole of a bowling ball of said means for forming a contact area with a finger pad.

Examiner's grounds of rejection is the statement,

[a]s to claims 38, 39, 45 and 53, strap is capable as functioning as a 'limit means' and is considered a 'raised surface' when the limitations in the claims are given their broadest possible meaning.

does not explain how the elements of Fowble cited by Examiner are the same as the recited claimed elements. Examiner has stated an opinion without showing by a rationale or evidence meets the recited claim limitations. Examiner is required to explain why or how Fowble teaches to one skilled in the art of bowling, element "a," is a "limit means," meeting the full recitation as claimed or a "raised surface," according to the full recitation as claimed. Examiner's statement is incomplete and an opinion because it lacks that explanation of the record facts of Fowble in relation to the explicit claim recitations and, as an opinion or conclusion without facts or rationale, is without an argument and leaves the Applicants without a reasonable opportunity to rebut.

Examiner's rejection of appellants' claims as anticipated is incomplete and fails to meet the Examination Standard of Substantial Evidence and must be vacated.

g) Claims 49, 50, 52, and 56.

Examiner's statement that,

Fowble is considered substantially 'more rigid material,' referring to Fowble col.1, line 35, and "[t]he shield of [Fowble] is inherently capable of resisting deformation from a force of a bowling ball during such intended use,

does not the record facts explicit in, or record facts necessarily following from, Fowble or acceptable reasoning to support the examiner conclusion to meet the examination standard of substantial evident and should be vacated.

Examiner has not shown by any record element in these claims or any other claims or shown by any rationale that the examiner cited disclosed elements of Fowble meets the claim elements or that Fowble or are inherently capable of meeting those elements set forth in the claim recitations. Examiner must be specific in providing a record demonstrating each recited element in the claims are disclosed in Fowble. Examiner's grounds of rejection are not capable of being read with the specificity required under the standards for examination set forth in Section A, 1, 2 and 3 above.

Examiner relies on the doctrine of inherency. However, a proper showing of inherency requires Examiner must provide an rationale or evidence tending to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. See Section A. 3. above, MPEP §2112 Requirements of Rejection Based on Inherency; Burden of Proof.

Examiner's statement does not meet the requirement set forth in the MPEP for showing inherency, fails to meet the Examination Standard of Substantial Evidence and must be vacated.

h) For claim 43, and 46-56 and 58,

Examiner's statement,

Fowble inherently is capable of spreading a force uniformly over a contact area;
and for claims 46-56 and 58, Examiner's statement,

Fowble shows the function of placing a finger in the shield and having a force exerted
between a users finger and the shield to be the result of performing a task. These forces
between the finger and the shield form 'a contact area', 'spread force produced' during the
task (sic) . . . spread the for (sic) 'uniformly,' . . . resist deformation by the materials
properties . . . and spreading over the widest area,

fails to meet the examination standard stated in Section A. 1. 2, and 3 above and as Examination Standard of
Substantial Evidence for the reasons given above with respect to claims 49, 50, 52, and 56.

i) Examiner's grounds of rejection fail to set forth the specific elements in Fowble which match the recited
claim elements in any of the pending claims and examine's grounds of rejection under 35 U.S.C. 102 fails as
incompetent under the Examination Standard of Substantial Evidence.

E.

Claims 35, 37, 44 and 57 Are Patentable In View Of Any Combination Of Fowble Or Pratt

1.

The Limits Of the Fowble and Pratt Disclosures

The limits of the Fowble disclosure as presented in D.1, above is restated as if repeated here in its
entirely.

The disclosure of Pratt is limited to a glove with a finger grip insert. The inserts are resilient for use
in picking up coins. .

Pratt teaches away from a rigid insert or any insert which protects the finger from a force against the
finger pad, as the glove tips must be tactilely resilient so the user can feel coins, the force of the coins.
See Pratt, col. 2, lines 1-26, and Pratt, generally.

2.

Limit of Examiners stated grounds of rejection

Examiner's rejection is limited to the statements,

1) As to claims 35 and 58, adjustable straps in finger shields and hand protectors are well known to
secure same apparatus so one could achieve a desired fit; and

2) As to claims 37 and 44, Fowble fails to discuss any parts of a glove with respect to the use of his
finger shield. Pratt shows combining finger inserts with gloves in order to combine the benefits of the insert with

those of a gloved hand. To have included the insert of Fowble in a glove would have been obvious in order to protect the finger as well as the hand as a result of the benefits of the glove.

3.

Legal Concept of Prima Facie Obviousness, Manual of Patent Examining Procedure (MPEP) §2142

There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." In *re* Rouffel, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

MPEP §2143.01 Suggestion or Motivation To Modify the References

In a rejection based on obviousness (35 U.S.C. 103) the Court in *In re Sang-Su Lee* 277 F.3d 1338, 1342, 1343 (Fed. Cir. January 18, 2002), said (repeated from above),

The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ("a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'" (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references."); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ("teachings of references can be combined only if there is some suggestion or incentive to do so.") (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed"); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references").

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done.

To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the reference.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

There is no teaching or suggestion in Fowble or Pratt of combining the flexible inserts of Pratt into the protector of Fowble intended to be of vulcanized rubber to resist the lateral chaffing or galling forces, along the finger surface. Pratt's inserts are flexible to be tactilely responsive to the feel of coins in response to the force of the finger against the coins.

4.

Examiner's grounds for rejection fail to meet examination standards.


Examiner's limited statements above, do not provide a rationale or record based evidence sufficient to meet the Examination Standard of Substantial Evidence and cannot support a rejection under 35 USC 103. Examiner's rejection under 35 USC 103 should be vacated.

F. Appellants include in this appeal a request that this application not be remanded. In the history of this application, due to a failure to state grounds for rejection with particularity, this application was remanded by the Board of Appeals without a hearing. A companion application 09/396.530 filed 9/15/1995 was remanded due to the same examination deficiencies. Appellants have been delayed by the failure of examiner to provide an examination meeting the standards for examination as set forth by the Court of Appeals for the Federal Circuit or by the MPEP. Appellants request a full, fair and impartial examination according to these examination standards.

All Record Claims Should Be Allowed

Applicant has shown all of the record claims, as presented in the Appendix, are allowable.

Submitted.

 10/24/2002
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